TITAN (M) SDN BHD

v.

THE REGISTRAR OF TRADE MARKS

HIGH COURT MALAYA, KUALA LUMPUR
RAMLY ALI J
[NOTICE OF MOTION NO: D5 (IP)-25-15-2008]
20 NOVEMBER 2008

TRADE MARKS: *Registration - Application for - Trade Marks Act 1976, s. 10(1) - Whether complied with - Whether trade mark 'SURE-Loc' a name of individual or company - Whether 'SURE-Loc' has direct reference to character or quality of appellant's goods - Distinctiveness - Whether descriptive words could be distinctive - Whether 'SURE-Loc' highly descriptive of goods - Whether trade mark registrations territorial in nature - Whether registrar's decision correct and made in accordance with the Trade Marks Act 1976 - Whether registrar ordered to pay costs - Trade Marks Act 1976, s. 63(1)*

This was the appellant's appeal against the decision of the Registrar of Trade Marks Malaysia (the registrar) rejecting the appellant's application for registration of the trade mark 'SURE-Loc' on the ground that the appellant had failed to comply with the requirements under s. 10(1) of the Trade Marks Act 1976 (the TMA). The registrar had in his grounds of decision, *inter alia*, noted that (a) a mark may be registered as a trade mark in Malaysia provided the mark satisfies one of the five criteria in s. 10(1) of the Trade Marks Act 1976; (b) all criteria in s. 10(1) of the Trade Marks Act 1976 are to be read and applied disjunctively; (c) s. 10(1)(a) and s.10(1)(b) of the Trade Marks Act 1976 was not applicable in regard to the application; (d) the Mark was not an invented word according to the requirements of s. 10(1)(c) of the Trade Marks Act 1976; (e) the Mark refers directly to the goods sold under the Mark and therefore did not comply with the requirements of s. 10(1)(d) of the Trade Marks Act 1976; (f) the Mark was not distinctive and therefore did not comply with the requirements of s. 10(1)(e) of the Trade Marks Act 1976; and (g) the Mark had not obtained a secondary meaning, deeming it unfit to be registered as a trade mark as not enough evidence of use was adduced *via* a statutory declaration submitted by the applicant to the registrar. The other issues raised by the appellant were (i) whether the said Mark had acquired factual distinctiveness as the appellant had registered the

said Mark as a trade mark in Singapore and (ii) whether the appellant could pray for a prayer that the costs of this appeal and the costs of proceedings before the registrar be borne by the registrar.

Held (dismissing the appeal):

(1) The appellant's trade mark 'SURE-Loc' was neither a name of an individual nor a company nor a firm and therefore obviously did not fulfill this criteria of registrability under s. 10(1)(a) of the TMA. It was also beyond doubt that the appellant's trade mark 'SURE-Loc' was not a signature and therefore did not fulfill this criteria of registrability under s. 10(1)(b) of the TMA either. (paras 12 & 13)

(2) The word 'SURE-Loc' which has been mis-spelt for the words 'SURE-Lock' could not be an invented word. The combination of the word 'SURE' (which carries a meaning) and the word "Loc' (which does not have a meaning), did not amount to an invented word. The words 'SURE-Loc' which phonetically sounds as "SURE-Lock' when pronounced would surely compute a meaning in the minds of the general public that 'certainly the lock would secure something', there words surely could not be invented words as invented words do not carry a meaning until it becomes a generic word. The appellant's Trade Mark was not registrable pursuant to s. 10(1)(c) of the TMA as the appellant's Trade Mark "SURE-Loc' was not an invented word, hence not fulfilling this criteria either. (paras 17, 18, 20 & 25)

(3) The words 'SURE-Loc' together with the device of 'key lock' at the letter 'O' in the word 'Loc' has a direct reference to the character or quality of the appellant's goods *viz* doorlocks, cylindrical locks, hinges, door handles etc. The appellant's goods were clearly related to a securing apparatus which was used to secure, fasten or lock up something. The appellant's Trade Mark clearly described the character of the appellant's goods *viz* 'a lock that will surely lock, hence safeguarding the things that has been locked'. Words which are descriptive or words having direct reference to the goods or services, as to the characteristics or qualities of the goods or services, are common property and therefore could not be monopolized by any person. In view of the fact that other locksmiths or traders in the security line of business may also wish to describe their locks and fastening apparatus as goods which

would be securely locked up and fastened as 'their goods too will be SURE to LOCK' when used, the court was of the view that the appellant's Trade Mark was certainly not registrable pursuant to s. 10(1)(d) of the TMA. (paras 27, 28, 30, 31 & 36)

(4) The appellant's Trade Mark could not be inherently distinctive as it was highly descriptive of the appellant's goods. Words which are descriptive could not be distinctive unless such words have acquired a secondary meaning. The plaintiff or applicant has to show that a 'secondary meaning' has been acquired in law such that the public associates the name with them. Where a trader chooses a name which describes his product or business, a secondary meaning must be shown. However, the appellant herein had neither shown nor proved that the appellant's Trade Mark had achieved a secondary meaning. All the evidence tendered by the appellant in this case were merely sales and invoices illustrating the appellant's clients who purchase the appellant's goods containing the appellant's Trade Mark including some advertisements. These evidence did not in any manner illustrate that the public had associated the appellant's Trade Mark with the appellant's goods and in that it had acquired a secondary meaning. The words 'SURE-Loc' was indeed highly descriptive of the appellant's goods. The appellant's Trade Mark, immaterial of the amount of evidence submitted, could not be distinctive and as such did not qualify the requirements of s. 10(1)(e) of the TMA. (paras 41, 42, 46 & 50)

(5) Trade Mark registrations are territorial in nature. The registration obtained by the appellant for the appellant's Trade Mark in Singapore was not binding on the registrar as the evaluation of the appellant's application was strictly made pursuant to the provisions of the Malaysian TMA. The respondent had rejected the appellant's application pursuant to the Malaysian TMA. The issue of inconsistency of registration as raised by the appellant did not arise because trade mark law and protection is territorial in nature. (paras 52 & 53)

(6) Section 63(1) of the TMA clearly states that the registrar shall not be ordered to pay the costs of any parties. The registrar has a statutory obligation to ensure that the provisions of the TMA are duly complied with in processing an application for registration of a trade mark. Such obligations are mandatory in

nature and as such the decisions of the registrar are always to be based on the provisions of the TMA, supported with the principles of trade mark law. (paras 54 & 55)

(7) Based on the above reasons, the registrar's decision was correct as it was made in accordance with the TMA. (paras 56 & 57)

Case(s) referred to:

American Screw Coy's Application (Torq-set TM) [1959] 14 RPC 344 ***(refd)***
Bata Ltd v. Sim Ah Ba & Ors [2006] 3 CLJ 393 CA ***(refd)***
Burroughs Wellcome & Co's Trade Mark [1904] 21 RPC 217 ***(refd)***
Cellular Clothing Co Ltd v. Maxton & Murray [1899] AC 326 ***(refd)***
Eastman Photographs Materials Co Ltd's Application [1895-9] All ER 1633 ***(refd)***
Eastman Photographs Materials Co Ltd's Application [1898] 15 RPC 476 ***(refd)***
Electrix Ld's Application [1959] RPC 283 ***(refd)***
Joseph Crossfield & Sons Limited, In re California Fig Syrup Company, In re HN Brock & Co Limited [1910] 1 Ch 130 ***(refd)***
Lim Yew Sing v. Hummel International Sports & Leisure A/S [1996] 4 CLJ 784 ***(refd)***
McAlister & Co Ltd v. Pasuma [1961] 1 LNS 63 ***(refd)***
Orlwoola Trade Marks [1909] 26 RPC 854 ***(refd)***
Oze Marketing Sdn Bhd v. Twenty First Century Products Sdn Bhd [1999] 4 CLJ 823 HC ***(refd)***
Philippart's Trade Mark [1908] 25 RPC 565 ***(refd)***
Re Smith Kline & French Laboratories Ltd's Cimetidine Trade Mark [1991] RPC 17 ***(refd)***
Service Master (M) Sdn Bhd v. MHL Servicemaster Sdn Bhd & Anor [1998] 1 CLJ 459 HC ***(refd)***
Smith, Kline & French Laboratories Ltd's Trade Mark Application [1976] RPC 511 ***(refd)***
W and G du Cross Ld Application [1913] 30 RPC 660 ***(refd)***
Yomesihu Seizo Co Ltd & Anor v. Sinma Medical Products (S) Pte Ltd [1991] 3 CLJ 2357; [1991] 4 CLJ (Rep) 1189 HC ***(refd)***
Yong Sze Fan & Anor v. Sharifah Mohd Tamin & Ors [2008] 8 CLJ 613 HC ***(refd)***

Legislation referred to:

Trade Marks Act 1976, ss. 10(1)(a), (b), (c), (d), (e), (2A), (2B), 63(1)

For the appellant - Sonya Liew; M/s Goh Wong Pereira
For the registrar - Rahamatthunnisa Mohamed Nizamuddin Legal Officer Intellectual Property Corporation of Malaysia

Reported by Suhainah Wahiduddin

JUDGMENT

Ramly Ali J:

Introduction

[1] This is the appellant's appeal against the decision of the Registrar of Trade Marks Malaysia (the registrar) dated 28 March 2008 rejecting the appellant's application for registration of the trade mark "SURE-Loc" on the ground that the appellant has failed to comply with the requirements under s. 10(1) of the Trade Marks Act 1976 (the TMA).

Brief Facts

[2] The appellant is a company incorporated in Malaysia and having its place of business at No. 5 & 7, Lorong 13/6A, Subang Jaya Industrial Estate, 47500 Subang Jaya, Selangor Darul Ehsan.

[3] The appellant had applied for registration of a trade mark (the 'Mark') in Class 6 on or about 11 May 2000, wherein such application was provided with the application number 2000-06118.

[4] By a notice dated 20 September 2002, the Registrar of Trade Marks at the Malaysian Intellectual Property Corporation (the 'registrar') objected to the appellant's registration due to non compliance of s. 10(1)(d) and (e) of the Trade Marks Act 1976. In reply to the registrar's objections, the appellant had submitted written submissions to the registrar together with the relevant statutory declaration on 5 November 2002. Thereafter, the registrar had forwarded his objections against the registration of the Mark.

[5] On 5 May 2005, the appellant filed further submissions with the registrar. On 18 June 2007, a hearing was conducted in regard to the objections made by the registrar under s. 10(1)(d) and (e) of the Trade Marks Act 1976. The decision following the hearing was delivered on 28 March 2008, where the application was rejected.

[6] The appellant thereafter requested for statement of grounds for decision on 8 April 2008. Pursuant to the request for grounds for decision, the same was delivered on 30 June 2008 to the appellant. The appellant then filed a notice of motion to appeal against the decision of the registrar of the Trade Marks, supported by the affidavit of Valentino Chin Chou Voon affirmed on 29 July 2008.

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Registrar's Decision

[7] The registrar had in his grounds of decision dated 30 June 2008, *inter alia* noted that:

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(a) a mark may be registered as a trade mark in Malaysia provided the mark satisfies one of the five criteria in s. 10(1) of the Trade Marks Act 1976;

(b) all criteria in s. 10(1) of the Trade Marks Act 1976 are to be read and applied disjunctively;

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(c) the s. 10(1) and s. 10(1)(b) of the Trade Marks Act 1976 is not applicable in regard to the application;

(d) the Mark is not an invented word according to the requirements of s. 10(1)(c) of the Trade Marks Act 1976;

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(e) the Mark refers directly to the goods sold under the Mark and therefore does not comply with the requirements of s. 10(1)(d) of the Trade Marks Act 1976;

E

(f) the Mark is not distinctive and therefore does not comply with the requirements of s. 10(1)(e) of the Trade Marks Act 1976; and

(g) the Mark has not obtained a secondary meaning, deeming it unfit to be registered as a trade mark as not enough evidence of use was adduced *via* a statutory declaration dated 1 November 2002, submitted by the applicant to the registrar.

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Findings Of Court

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[8] The operative provisions in the present application is s. 10(1) of the TMA. The registrar has indicated in his grounds of decision that the said application before the registrar was rejected on the ground that the appellant's application does not fulfil at least one of the criteria laid down under s. 10(1) of the TMA.

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[9] Section 10(1) of the TMA provides:

> 10. Registrable trade marks
>
> (1) In order for a trade mark (other than a certification trade mark) to be registrable, it shall contain or consist of at least one of the following requirements:
>
> (a) the name of an individual, company or firm represented in a special or particular manner;

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(b) the signature of the applicant for registration or of some predecessor in his business;

(c) an invented word or words;

(d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or

(e) any other distinctive mark.

[10] It is clear from the above provisions that in order for a trade mark to be registrable, at least one of the criterias laid down under s. 10(1) must be fulfilled. If the appellant fails to do so, the registrar was right in rejecting the said application.

[11] The court shall now consider each and every single criterias or element of registrability provides under s. 10(1) and determine whether the registrar's decision in rejecting the said application is correct in law or not.

Section 10(1)(a) – Name of individual, company or firm represented in a special or particular manner

[12] It is beyond doubt that the appellant's Trade Mark, "SURE-Loc" is neither a name of an individual nor a company nor a firm and therefore obviously does not fulfill this criteria of registrability under s. 10(1)(a) of the TMA.

Section 10(1)(b) – Signature of the Applicant for Registration or of some predecessor in his business

[13] It is also beyond doubt that the appellant's Trade Mark, "SURE-Loc" is not a signature and therefore obviously does not fulfill this criteria of registrability under s. 10(1)(b) of the TMA, either.

Section 10(1)(c) – An invented word or words

[14] The appellant's Trade Mark "SURE-Loc" is not an invented word because the words "SURE-Loc" although has been mis-spelt for the words "SURE-Lock", phonetically the words "SURE-Loc" simply means that "it is sure to be locked" or "it will surely lock" or "there is no doubt that it will be locked".

[15] The word "SURE" is defined as follows:

(a) Webster's Third New International Dictionary
Safe, secure, free from danger, free from exposure to risk, safely secured from.

(b) The Oxford Dictionary, Thesaurus and Wordpower Guide
Certain, positive, convinced, confident, definite, assured.

(c) Longman Dictionary of Contemporary English
Having no doubt, confident in one's knowledge of something, certain to be true or exact.

(d) Kamus Inggeris Melayu Dewan
Certain, having no doubt.

[16] Although the word "Loc" has no meaning under the English language, however, when such word is pronounced, it has the same phonetic as the word "Lock" which carries a general meaning of an apparatus used for closing and fastening something.

[17] The word "SURE-Loc" which has been mis-spelt for the words "SURE-Lock" cannot be an invented word. Viscount Simonds J in the House of Lords case of *Electrix Ld's Application* [1959] RPC 283 concurred with the Courts of Appeals judgment at p. 286 which reads:

> As we understand it, is that, if a given word is for any reason unregistrable in its proper spelling, then, in as much as the Trade Marks appeal to the ear as well as to the eye, the objection (whatever it may be) to the registration of the properly spelt word applies equally to a word which is merely phonetic equivalent. Applying that view of the law to the facts of the present case, the Court of Appeal held that "electrix" being the phonetic equivalent of "electrics" and that word being unregistrable, "electrix" also was unregistrable".

[18] The combination of the word "SURE" (which carries a meaning) and the word "Loc" (which does not have a meaning), does not amount to an invented word. As per Lord Herschell at p. 485 in the case of *Eastman Photographs Materials Co Ltd's Application* [1898] 15 RPC 476:

> I don't think the combination of two English words is an invented word, even though the combination may not have been seen in use before, nor do I think that mere variation of the orthography

or termination of word would sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form.

[19] The court refers to the case of *Eastman Photographs Materials Co Ltd's Application* [1895-9] All ER 1633, which was relied upon by the appellant, whereby Lord Chancellor (Halsbury) quoted the contents of a report on the duties of the patent office, as follows:

> It is manifest that no one ought to be granted the exclusive use of a descriptive word of the quality or character of any goods. Such words of description are the property of all mankind and it would not be right to allow any individual to monopolize them and exclude others from their use. (at page 1635, para 30)
>
> Of course, also words which are merely misspelt but are nevertheless in sound ordinary English words, the use of which may tend to deceive, ought not to be permitted. (at page 1637, para 25)

[20] Since the words "SURE-Loc" which phonetically sounds as "SURE-Lock", when pronounced, would surely compute a meaning in the minds of the general public that "certainly the lock would secure something", these words surely cannot be invented words as invented words do not carry a meaning until it becomes a generic word.

[21] The same principle is clearly reflected in the case of *Joseph Crossfield & Sons Limited, In re California Fig Syrup Company, In re H.N. Brock & Co. Limited* [1910] 1 Ch 130 which is also relied upon by the appellant, whereby Cozens-Hardy M.R. held that:

> It seems to follow that a word, not being an invented word, ought not to be put on the register if the spelling is phonetic and resembles in sound a word which in its proper spelling could not be put on the register.

[22] This is further supported by the case of *Philippart's Trade Mark* [1908] 25 RPC 565 whereby Parker J held at p. 569 that:

> To be an invented word, a word must not only be newly coined, in the sense of not being already current in the English Language, but must be such as not to convey any meaning, or, at any rate, any obvious meaning to ordinary Englishmen. It must be a word having no meaning or no obvious meaning until one has been assigned to it.

[23] This case was followed by James Foong JCA in the Court of Appeal case of *Bata Ltd v. Sim Ah Ba & Ors* [2006] 3 CLJ 393 at p. 410 whereby the Court of Appeal held that the word "POWER" is not an invented word and it is a generic and common word.

[24] The word "SURE" is a common term in Malaysia which indicates a positive and certainty connotation whereby this word is also frequently used together with Bahasa Malaysia for example words such as "sure jadi", "sure mahal" or "sure boleh" etc. which indicates certainty. Therefore, the words "SURE-Loc" would also certainly indicate to the Malaysian public that the appellant's goods bearing the appellant's Trade Mark certainly be able to secure a lock and this carries a meaning which obviously means that the word "SURE-Loc" is not invented words.

[25] Based on the above, the court finds that the appellant's Trade Mark is not registrable pursuant to s. 10(1)(c) of the TMA as the appellant's Trade Mark "SURE-Loc" is not an invented word, hence not fulfilling this criteria either.

Section 10(1)(d) – A word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname

[26] The words "SURE-Loc" illustrate that the appellant's trade mark consist of words having direct reference to the character of the goods in question.

[27] The words "SURE-Loc" together with the device of "key lock" at the letter "O" in the word "Loc" has a direct reference to the character or quality of the appellant's goods *viz*. ironmongery, door locks, cylindrical locks, rim locks, latches, padlocks, floor springs of metal, hinges, door handles, pull and push bars and plates of metal. The appellant's goods are clearly related to a securing apparatus which is used to secure, fasten or lock up something.

[28] The words "SURE-Loc" together with the device of "key lock" at the letter "O" in the word "Loc" would indicate to the public that the appellant's goods are indeed secured when they are used and this clearly defines the character of the appellant's goods in that they will surely be securely locked up and fastened

and therefore, their belongings are safe from danger. This general understanding of the word "SURE-Loc" is supported by the ordinary meanings of the words "sure" as defined above and the ordinary meaning of "lock" which not only can be construed out of the pronunciation of the word "Loc" but also through the visual presence of the device of "key lock" at the letter "O" in the word "Loc".

[29] In determining the issue of direct reference, Lloyd Jacob J in the case of *American Screw Coy.'S Application (Torq-set TM)* [1959] 14 RPC 344 at p. 346 holds that:

> The question remains whether such reference is direct. In considering this question, the Registrar or Court is not in any way bound by strict grammatical usage, for the test is intended to relate to the conditions obtaining in industry and commerce. Direct reference corresponds in effect to aptness for normal description.

[30] The court is satisfied that the appellant's trade mark is not registrable under this criteria as it clearly describes the character of the appellant's goods *viz*. "a lock that will surely lock, hence safeguarding the things that has been locked". The court is guided to the case of *Burroughs Wellcome & Co's Trade Mark* [1904] 21 RPC 217 as per Vaughan William LJ at p. 226:

> ... when a man sits down to choose a trade mark, his mind will naturally run on words that are more or less cognate to the articles with reference to which the mark is proposed to be registered... for a word to be really descriptive it must describe something which is material to the composition of the article to which the trade mark is intended to apply.

[31] Words which are descriptive or words having direct reference to the goods or services, as to the characteristics or qualities of the goods or services, are common property and therefore cannot be monopolized by any person. As per Lord Herschell in the case of *Eastman Photographs Materials Co Ltd's Application* [1898] 15 RPC 476:

> In this circumstances it would obviously have been out of the question to permit a person by registering a Trade Mark in respect of a particular class of goods, to obtain a monopoly of the use of a word having reference to the character or quality of those goods. Vocabulary of the English language is common property: its belongs alike to all; and no one ought to be

A permitted to prevent the other members of the community from using, for purposes of description a word which has reference to the character or quality of goods.

[32] The words "SURE-Loc" conveys the characteristic of the appellant's goods bearing the appellant's Trade Mark whereby B such goods in its own nature itself has the main function of locking up or securing something. This main function of such goods which are used as locks or secured fastening of something, should be allowed to be described and used by any trader in the C locksmith business and no one person should be deprived of using such description.

[33] The case establishing the point that no one trader is allowed to monopolize as a trade mark, which words other traders may wish to use, is further illustrated in *Smith, Kline & French* D *Laboratories Ltd's Trade Mark Application* [1976] RPC 511 as per Lord Diplock at p. 538:

> However, long before the reference to inherent adaptability had been incorporated in the current statutes dealing with trade marks, E it had been held upon grounds of public policy that a trader ought not to be allowed to obtain by registration under the Trade Marks Act a monopoly in what other traders may legitimately desire to use ...

[34] The case of *McAlister & Co. Ltd v. Pasuma* [1961] 1 LNS F 63, illustrates that descriptive word which has reference to the character of the goods, should not enjoy exclusivity unless it has obtained a secondary meaning. As per Tan Ah Tah J:

> But I must confess that I have always thought and I shall think, that it should be made almost impossible for anyone to obtain the G exclusive right to the use of a word or term which is in ordinary use in our language and which is descriptive only ... .
>
> But where the plaintiffs' proof shows that the only representation by the defendants consists in the use of a term or terms which H aptly and correctly describes the goods offered for sale, as in the present case, it must be condition of the plaintiffs success that they shall prove that these terms no longer mean what they say – or no longer mean only what they say – but have acquired the secondary and further meaning that the particular goods are goods made by the plaintiffs, and, as I have already indicated, it is in I my view difficult to conceive cases in which the facts will come

up to this. Unless that be proved, there is no room for a charge of violation of any right, or indeed of a charge of fraud – for the defendants are only exercising the right which they possess as much as the plaintiffs do, and which every one has, to employ words in ordinary use which are an apt and proper description of the goods for sale.

[35] Therefore, in deciding whether the appellant's Trade Mark ought to be registered or not would depend on whether other traders may wish to use the same mark in their trading. As per Lord Parker J. in the case *W. and G. du Cross Ld. Application* [1913] 30 RPC 660 at p. 672:

> The applicants' chance of success in this respect must, I think, largely depend upon whether others are likely, in ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods. It is apparent from the history of Trade Marks in this country that both the Legislative and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Act a monopoly in what others may legitimately desire to use.

[36] In view of the fact that other locksmiths or traders in the security line of business may also wish to describe their locks and fastening apparatus as goods which would be securely locked up and fastened as "their goods too will be SURE to LOCK" when used, the court is of the view that the appellant's Trade Mark is certainly not registrable pursuant to s. 10(1)(d) of the TMA, either.

Section 10(1)(e) – Any other distinctive work

[37] As to what amounts of distinctiveness, s. 10(2A) and 10(2B) of the TMA state that:

> (2A) For the purposes of this section, "distinctive", in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

A (2B) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which:

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

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(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

C **[38]** This court had earlier in the case of *Yong Sze Fan & Anor v. Sharifah Mohd Tamin & Ors* [2008] 8 CLJ 613 at p. 627 held that:

The Court is of the view that the mark is distinctive within the meaning of the Trade Marks Act 1976 in that it is capable of
D distinguishing the goods of the respondents from the goods of other traders. The mark is both inherently and factually distinctive of the respondents in this case.

In deciding inherent distinctiveness, the case of *W & G Du Cros Ltd's Application* [1913] 30 RPC 660 can be relied upon. It was
E held by Lord Parker at p 671 as follows:

> The applicant for registration in effect says 'I intend to use this mark as a trademark ie, for the purpose of distinguishing my goods from the goods of other persons', and the Registrar or the court has to determine, before the
F mark is admitted to registration, whether it is such a kind that the applicant, quite apart from the effects of registration, is likely to attain the object he has in view. The applicant's chance of success in this respect, must, I think largely depend upon whether other traders are likely,
G in the ordinary course of their business and without improper motive, to desire to use the same mark, or some mark closely resembling it, upon or in connection with their own goods.

[39] The court finds that all the evidence tendered by the
H appellant would be insufficient to illustrate inherent distinctiveness, as the appellant's Trade Mark is highly descriptive of the appellant's goods whereby the words "SURE-Lock" (which phonetically sounds as "SURELOCK") may be wished to be used by other traders in describing the character and quality of their
I goods being locks or fastening apparatus as being gadgets which are certainly secured and locked up.

[40] In the case of *Re Smith Kline & French Laboratories Ltd's Cimetidine Trade Mark* [1991] RPC 17, the court held that even if a mark is completely or highly distinctive in fact, the mark will not be distinctive in law if it consists of ordinary English words of description which other traders might want to use. As per Peter Gibson J at p. 33:

> In considering whether the claimed trade mark is inherently adapted to distinguish, the court takes account of the likelihood that other traders may, without improper motive, desire to use the trade mark in relation to their own goods. On grounds of public policy a trader will not be allowed to obtain, by a trade mark registration, a monopoly in what other traders may legitimately wish to use …
>
> Thus, even if a mark is completely or highly distinctive in fact, the mark will not be distinctive in law if it consist or ordinary English words of description or praise or initials which other traders might have or want to use or geographical names, unless of such incongruity with the specified goods as would not occur to other traders to use in relation to similar goods …
>
> (see also: *Smith, Kline & French Laboratories Limited v. Sterling Winthrop Group Limited* [1975] 1 W.L.R. 914; and *Yorkshire Copper Works Limited v. Registrar of Trade Marks* [1954] 1 W.L.R. 554B).

[41] The court is of the view that the appellant's Trade Mark cannot be inherently distinctive as it is highly descriptive of the appellant's goods.

[42] Words which are descriptive cannot be distinctive unless such words have acquired a secondary meaning. This means that the plaintiff or applicant has to show that a 'secondary meaning' has been acquired in law such that the public associates the name with them. Where a trader chooses a name which describes his product or business, a secondary meaning must be shown. (see: *Service Master (M) Sdn. Bhd. v. MHL Servicemaster Sdn Bhd & Anor* [1998] 1 CLJ 459).

[43] It is not easy for a name descriptive of a product to acquire a secondary meaning. It must be by a course of dealing over many years. Lord Shand in *Cellular Clothing Co Ltd v. Maxton & Murray* [1899] AC 326, had even thought that a secondary meaning should not be made possible when he said:

> … it no doubt shews it is possible where a descriptive name has been used to prove that so general, I should rather say so

> universal, has been the use of it as to give it a secondary meaning … But I confess I have always thought, and I still think, that it should be made almost impossible for any one to obtain the exclusive right to the use of a word or term which is in ordinary use in our language and which is descriptive only – and, indeed, were it not for the decision in *Reddaway*'s case, I should say this should be made altogether impossible.

[44] Similarly, in the case of *Yomesihu Seizo Co. Ltd. & Anor v. Sinma Medical Products (S) Pte Ltd* [1991] 3 MLJ 251, relied upon by the appellant, Chan Sek Keong J at p. 254 held that:

> It is thus settled law that distinctiveness in relation to the use of descriptive words may be satisfied by adducing evidence that the words have acquired a secondary meaning in connection with the goods of the claimant. But, as the law does not permit any person to claim a proprietary right to the use of common words in a language, it is extremely difficult to establish that common words have acquired a secondary meaning in relation to the goods of the claimant. There are degrees of difficulty in proving a secondary meaning.

[45] In the case of *Oze Marketing Sdn. Bhd. v. Twenty First Century Products Sdn. Bhd.* [1999] 4 CLJ 823, Abdul Aziz J. held at p. 825 that:

> What secondary meaning would mean for the plaintiffs in this case is that although Memo Plus is descriptive of a memory-enhancing preparation, it has also become descriptive of a memory-enhancing preparation associated with the plaintiffs and no one else.

[46] The appellant in this case has neither shown nor proved that the appellant's Trade Mark has achieved a secondary meaning. All the evidence tendered by the appellant in this case are merely sales and invoices illustrating the appellant's clients who purchase the appellant's goods containing the appellant's Trade Mark including some advertisements. These evidence do not in any manner illustrate that the public has associated the appellant's Trade Mark with the appellant's goods and in that it had acquired a secondary meaning.

[47] Abdul Aziz J. in deciding that the evidence tendered by the Plaintiff is insufficient to establish a secondary meaning, in the case of *Oze Marketing Sdn. Bhd. v. Twenty First Century Products Sdn. Bhd. (supra)* further held at p. 826 that:

> In their written submission in reply, the plaintiffs seek to show the acquisition of a secondary meaning of the name Memo Plus

> by reference to certain exhibits showing the sales performance of their product and their efforts in promoting if through publicity and advertisement – exhs. SK-7 and SK-8 to encl (3). But I do not think they are sufficient for proof of the acquisition of a secondary meaning. In the first place, those exhibits were not exhibited for the purpose of proving the acquisition of a secondary meaning. ... They do not show the use by the plaintiffs of the name Memo Plus by itself, which is the name that is relevant to the questin of secondary meaning.

[48] Similarly James Foong JCA in the case of *Bata Ltd v. Sim Ah Ba & Ors (supra)* held at p. 411 that:

> We agree that if a word in a trade mark has achieved a secondary meaning to distinguish it from the goods of the proprietor of that trade mark, then such proprietor may be entitled to the exclusive use of it. But in this case there is insufficient evidence advanced by the appellant to convince us of this.

[49] The court is of the view that the words "SURE-Loc" together with the device of "key lock" at the letter "O" in the word "Loc" (visual representation) and the phonetic pronunciation as "SURE-Lock" (phonetic representation) is indeed highly descriptive of the appellant's goods and the appellant's Trade Mark is therefore not registrable under the TMA. As per Farwell L.J. in *Orlwoola Trade Marks* [1909] 26 RPC 854 at p. 863:

> All Wool" or "All Woolly" cannot possibly be regarded as adapted to distinguish woollen goods: they are purely descriptive of their nature. I doubt if any amount of evidence could prove that they had lost their primary and acquired a secondary meaning. It can make no difference whether the words are spelt phonetically, fantastically, or conventionally; they are registered in respect of all wool goods and to the ear they mean all wool.

[50] In view of the fact that other locksmiths or traders in the security line of business may also wish to describe their locks and fastening apparatus as goods which would be securely locked up and fastened as "their goods too will be SURE to LOCK" when used, the court is satisfied that the appellant's Trade Mark, immaterial of the amount of evidence submitted, cannot be distinctive and as such does not qualify the requirements of s. 10(1)(e) of the TMA, either.

Registration In Singapore

[51] The appellant argued that the said Mark has acquired factual distinctiveness as the appellant had registered the said Mark as a trade mark in Singapore (*vide* registration no. T01/00009B).

[52] The court is of the view that the trade mark registrations are territorial in nature. The registration obtained by the appellant for the appellant's Trade Mark in Singapore is not binding on the registrar as the evaluation of the appellant's application is strictly made pursuant to the provisions of the Malaysian TMA. The respondent had rejected the appellant's application pursuant to the Malaysian TMA. The issue of inconsistency of registration as raised by the appellant does not arise because trade mark law and protection is territorial in nature.

[53] This fact is clearly envisaged in the case of *Lim Yew Sing v. Hummel International Sports & Leisure A/S* [1996] 3 MLJ 7, whereby Mahadev Shanker JCA at p. 12 para 1 that "Trade mark law is very territorial in many aspects."

Issue Of Costs

[54] It is noted that the appellant in this case has prayed for a prayer that the costs of this appeal and the costs of proceedings before the registrar be borne by the registrar. The court cannot agree on this issue on the ground that s. 63(1) of the TMA clearly states that the registrar shall not be ordered to pay the costs of any parties. Section 63(1) of the TMA states that:

> In all proceedings before the Court under this Act, the Court may award to any party such costs as it may consider reasonable and the costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any of the other parties.

[55] The registrar has a statutory obligation to ensure that the provisions of the TMA are duly complied with in processing an application for registration of a trade mark. Such obligations are mandatory in nature and as such the decisions of the registrar are always to be based on the provisions of the TMA, supported with the principles of trade mark law.

Conclusion

[56] Having supported his decision (in rejecting the appellant's application for non-compliance with at least one of the registrability criteria of s. 10(1) of the TMA), the court is satisfied that based on the above reasons and decided cases, the registrar's decision is correct as it was made in accordance with the TMA.

[57] Therefore, the court rules that the appeal by the appellant is dismissed with costs.